



THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Appellants:

Akihiro DENDA et al.

Art Unit: 2166

Application No.: 10/058,788

Examiner: M. Ali

Filed: January 30, 2002

Docket No.: 107156-00094

For: INFORMATION RECORDING AND REPRODUCING APPARATUS, METHOD
OF APPENDING TITLE INFORMATION, AND PROGRAM RECORDING
MEDIUM HAVING RECORDED TITLE INFORMATION APPENDING
PROCEDURE PROGRAM

BRIEF ON APPEAL

Date: April 5, 2007

I. INTRODUCTION

This is an appeal from the action of the Examiner dated August 3, 2006, finally rejecting Claims 1-10, as being unpatentable over certain prior art under 35 U.S.C. § 103. A Notice of Appeal was timely filed on November 3, 2006 with a request for a Pre-Appeal Review. On January 5, 2007, a Notice of Panel Decision From Pre-Appeal Review was issued continuing the rejection of claims 1-10. This Brief is being timely filed within the two month time period from the mailing of the Notice of the Panel Decision.

II. REAL PARTY IN INTEREST

The real party in interest in the present application is Pioneer, Corp. the assignee of record.

04/06/2007 HMARZI1 00000030 10058788

02 FC:1402

500.00 0P

III. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellants or Appellants' representative which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

IV. STATUS OF CLAIMS

Claims 1-10 are pending. Claims 1-10 are rejected. Claims 1-10 are being appealed.

V. STATUS OF AMENDMENTS

All amendments have been entered and/or will be entered upon filing of the instant Appeal Brief.

VI. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention relates to an information recording and reproducing apparatus for recording program information reproduced from an information recording medium or program information supplied via a communication network into recording device, a method for appending title information to program information, and a program recording medium having recorded a title information appending procedure program for allowing a computer to execute such a method.

An embodiment of a system including the claimed information recording and reproducing apparatus (5) is illustrated in Figure 1 and includes a first recording unit

(ST) provided in the recording device (5), for recording program information from the information recording medium (illustrated here as an optical disc (2)) or program information supplied via the communication network (15); a second recording unit (DB) for recording title information corresponding to said program information prior to recording said program information; and control means (11) for, when the program information is recorded into the first recording medium (ST), (a) obtaining management information (TOC or ATR) for managing said program information recorded in the information recording medium (2) or supplied via the communication network (15), (b) in case that the title information corresponding to the program information is obtained by searching through the second recording unit (DB) based on the management information obtained (TOC or ATR), appending the title information obtained to the program information so as to be recorded into the first recording unit (ST), and (c) in the case that the title information corresponding to the program is not obtained by searching through the second recording unit (DB) based on the management information obtained (TOC or ATR), appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit (ST). The title information stored in the second recording unit (DB) comprises at least one of the disc title, the name of the artist, genre, the year of sale of disc, track title, and artist(s) for respective track(s).

This apparatus provides for a recording and reproducing apparatus that is capable of recording program information such as music from a recording medium such as a CD, wherein the recording apparatus includes a database of information regarding music including album titles, artists, genres of music, the year of sale of the disc, and

track title that is pre-recorded. This pre-recorded information is searched at the time that the music is recorded from the CD and stored in a recording medium such as a hard drive in the apparatus. The claimed invention provides not only for the title, artist, etc. information to be appended to the recorded music, but also provides that a flag indicating the absence of title information will be recorded if no corresponding information is found.

Figure 3 illustrates subject matter in dependent claims 2-4, 6-7, and 9-10, wherein in operation, when updated title information is supplied to the apparatus (5) whether via recording medium (2) or via the communication network (15), the control means (11) records the updated title information into the second recording unit (DB) and searches through the updated second recording unit (DB) for the title information corresponding to the program information appended with information indicating an absence of the title information. When the title information is obtained, the control means (11) appends the obtained title information to the program information so as to be recorded in the first recording unit (ST).

Thus, the corresponding title information is updated without requiring manual user input or manual user review of the tracks with missing information by searching for the title information indicating an absence of the title information and appending any title information obtained as updated title information.

VII. GROUNDS OF REJECTION

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,711,343 to Matsumi et al. ("Matsumi") in view of U.S. patent No. 6,385,152 to Fujinamo ("Fujinamo").

VIII. APPELLANTS' ARGUMENTS

A. Legal Overview

Several basic factual inquiries must be made to determine obviousness or non-obviousness of patent application claims under 35 U.S.C. § 103. These factual inquiries are set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966):

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; the level of ordinary skill in the pertinent art resolved. Against this backdrop, the obviousness or non-obviousness of the subject matter is determined.

The specific factual inquiries set forth in *Graham* have not been considered or properly applied by the Examiner formulating the rejections of the claims. Particularly, the differences between the prior art and the claims were not properly determined. As stated by the Federal Circuit in *In re Ochiai*, 37 U.S.P.Q. 2d 1127, 1131 (Fed. Cir. 1995):

The test of obviousness *vel non* is statutory. It requires that one compare the claim's subject matter as a whole with a prior art to which the subject matter pertains. 35 U.S.C. § 103.

The inquiry is *highly fact-specific by design*....When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). (Emphasis added.)

Thus, the U.S. Patent and Trademark Office ("PTO") bears the burden under 35 U.S.C. § 103 of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d at 1598. A *prima facie* case of obviousness is established only if the teachings of the prior art would have suggested the claimed subject matter to a person

of ordinary skill in the art. If an Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993). "If examination....does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to the grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1145 (Fed. Cir. 1992).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

Further, in order to establish *prima facie* obviousness, "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under § 103, there must be a showing of proper motivation to do so. The PTO "can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fine*, 5 U.S.P.Q.2d at 1598. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). Further, the reason, suggestion, or motivation to combine the teachings of the prior art may not come from the applicant's invention itself." *In re Oetiker*, 997 F.2d at 1447.

The use of pure hindsight is entirely improper in the context of an obviousness rejection. As the Court of Appeals for the Federal Circuit clearly and unequivocally indicated in *In re Rouffet*, 149 F.3d at 1357:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet involved the reversal of both an Examiner and the Board of Patent Appeals for improperly combining a variety of features from various references in order to reject claims as obvious. Neither the Examiner nor the Board cited a motivation from the art itself for naming the specific combinations, instead using merely a “rote invocation” of the presence of a high level of skill in the field to supply a motivation to combine the references.

The Appellants respectfully submit that the Examiner has not made a proper *prima facie* rejection under 35 U.S.C. § 103(a), because the combination of prior art references cited fails to teach or suggest the present invention and because it would not be obvious to combine the cited references.

B. The Cited Art Fails to Teach or Suggest All Claimed Elements

1. Rejection of Independent claims 1, 5, and 8

Claims 1, 5, and 8 recite an apparatus, method, and a program recording medium for appending title information to recording program information reproduced from an information recording medium or program information supplied via a communication network into recording device, including, in part, control means for, when said program information is recorded into said first recording unit, (a) obtaining

management information for managing said program information recorded in the information recording medium or supplied via the communication network, (b) in case that the title information corresponding to said program information is obtained by searching through a second recording unit based on the management information obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit, and (c) in case that the title information corresponding to said program information is not obtained by searching through said second recording unit based on the management information obtained, appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit, wherein the second recording unit is provided in said recording device for recording title information corresponding to said program information prior to recording said program information, and wherein said title information comprises at least one of disc title, the name of artist, genre, the year of sale of disc, track title and the artist(s) for respective track(s)

Matsumi teaches a recording/reproducing apparatus including means for recording data received from transmission/reception means on a recording medium during reception and/or transmission.

However, Matsumi does not disclose or suggest control means for, when program information is recorded into a first recording unit, at least (b) in case that the title information corresponding to the program information is obtained by searching through a second recording unit based on management information obtained, appending the title information obtained to said program information so as to be recorded into the first recording unit and (c) in case that the title information is not

obtained by searching through said second recording unit based on the management information obtained, appending information indicating an absence of the title information to said program information so as to be recorded into the first recording unit.

The section of Matsumi referenced as teaching (b) merely describes recording a start and stop position and file system information on a recording medium (See column 25, lines 6-10) and as teaching (c) describes the situation wherein an additional recording is carried out in an apparatus that does not conform to Matsumi's apparatus. In this situation, previously recorded file system information A will not be recognized and will be recorded over so that information A is deleted. (See column 27, lines 16-29 and Figure 12 (b) showing the appended recorded data recorded over the previous information A as shown in Figure 12(a)). This causes the recorded data to be in an unfiled condition for Matsumi's apparatus. Thus, the data must have file system data B recorded in order to have the normal condition restored.

Rather than one recording apparatus that searches through a second recording unit within the apparatus for title information corresponding to program information recorded in a first recording unit within the apparatus and indicates an absence of title information for the program information in that first recording unit if such title information is not found, as recited in claim 1, Matsumi teaches that previous file system information may be go unrecognized by a second nonconforming recording apparatus and be deleted and recorded over, placing the recording medium in an unfiled status for the first, conforming apparatus.

Furthermore, Matsumi does not teach the recording apparatus including a second recording unit provided in the recording device for recording title information corresponding to the program information prior to recording the program information.

The Examiner again cites the section of Matsumi that teaches a second, nonconforming recording device recording over the previous file system information A because it is a separate device that does not recognize information A.

Matsumi teaches a recording medium or tape, on which data is written and then file system information A is written. (See Figure 12A). Matsumi fails to disclose both a second recording unit comprised in the recording device and the second recording unit recording title information prior to recording program information. In contrast, Matsumi teaches in Figs. 12A-12C that the data (which the Examiner asserts is similar to the program information (not admitted)) is written on the tape, first, before the writing or recording of file system information A (which the Examiner asserts is similar to the title information (not admitted)) (Col. 27, lines 16-28). Also shown in Figs. 12A-12C, either file system information A or file system information B are appended to the end of the data. As such, each of these two file systems must be recorded on the tape after the data or the append-recorded data. Thus, Matsumi fails to disclose or suggest a second recording unit for recording title information corresponding to said program information prior to recording said program information, as recited in independent claims 1, 5 and 8.

Independent claims 1, 5 and 8 also recite at least "searching through a second recording unit based on management information obtained," the second recording unit being "provided in said recording device for recording title information corresponding to . . . program information prior to recording [the] program information." The title

information is "appended" to the program information once it is found to be recorded into the second recording unit.

The Examiner also asserts that Matsumi teaches the function of searching through the second recording unit for the title information and refers to Col. 25, lines 6-10 and Col. 27, lines 30-34 of Matsumi. However, a closer examination of Matsumi reveals that Matsumi merely teaches searching the file system information A or B, as indicated in Figs. 6, 7, 12C, 16B and 17, and the title information found in the search is not appended to the program information (Col. 24, lines 4-10). Matsumi merely teaches appending a valid file system information after the last program or data file is recorded. There is no teaching or suggestion in Matsumi that the title information is appended to each individual data file, as recited in independent claims 1, 5 and 8.

Additionally, the Examiner alleges that Matsumi teaches that the title information includes at least one of disc title, the name of an artist, genre, the year of sale of the disc, track title and the artist for respective tracks, and points to Fig. 32 (December 16, 2005 Office Action, page 5, lines 9-11). However, a closer examination of Matsumi and, specifically, Fig. 32, reveals that Fig. 32 is a block diagram showing the configuration of a computer that includes a processor 251, a memory 252, a bus 253, several interfaces 254 and 255, a hard disk 257, a reception command 263, and a writing command 264 (Col. 42, lines 24-36).

Accordingly, it is clear that Matsumi merely teaches a computer configuration and fails to teach that the title information comprises at least one of disk title, the name of an artist, genre, the year of sale of the track, track title, and the artist for respective tracks, as recited in independent claims 1, 5 and 8. Even assuming, without admitting, that

Matsumi teaches in Fig. 32 that the file information may include file name, file size, recording start position and title recorded data, Matsumi fails to teach or suggest that the title information includes the above-described features of the independent claims.

Fujinami teaches a method to prevent new data from being written over already recorded data by mistake (Abstract). The Appellants note that Fujinami is cited as teaching a communication network. Therefore, the Appellants submit that even if Fujinami were combined with Matsumi (not admitted), the combination fails to cure the above noted deficiencies in Matsumi in disclosing or rendering obvious the features of independent claims 1, 5 and 8.

For at least the reasons listed above, the Appellants submit that the cited prior art fails to disclose or suggest the inventions as recited in claims 1, 5, and 8.

2. Rejection of Dependent Claims 2-4, 6-7, and 9-10

Claims 2-4, 6-7, and 9-10 depend from independent claims 1, 5, and 8, respectively. In addition to the arguments listed above, the Appellants submit that, contrary to the Examiner's assertion, Matsumi in view of Fujinami fail to teach or suggest at least when updated title information is supplied, recording the updated title information into the second recording unit, searching through the second recording unit (after updating) for the title information corresponding to the program information appended with the information indicating the absence of the title information, and when the title information corresponding to the program information is obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit, as recited in claims 2-4, 6-7, and 9-10.

The referenced section of Matsumi merely teaches the situation wherein an additional recording is carried out in an apparatus that does not conform to Matsumi's apparatus. In this situation, previously recorded file system information A will not be recognized and will be recorded over so that information A is deleted. (See column 27, lines 16-29 and Figure 12 (b) showing the appended recorded data recorded over the previous information A as shown in Figure 12(a)). This causes the recorded data to be in an unfiled condition for Matsumi's apparatus. Thus, the data must have file system data B recorded in order to have the normal condition restored.

Matsumi does not disclose or suggest updating title information into a second recording unit, when updated title information is supplied by way of an information recording medium or via the communication network.

Matsumi does not disclose or suggest searching through the second recording unit (after updating) for title information corresponding to program information, stored in a first recording unit, appended with information indicating an absence of title information.

Matsumi does not disclose or suggest when the title information corresponding to program information indicating an absence of title information is found appending the title information obtained to the program information so as to be recorded in the first recording unit.

As noted above, Fujinamo teaches a method to prevent new data from being written over already recorded data by mistake (Abstract) and is cited as teaching a communication network. Therefore, the Appellants submit that Fujinamo fails to cure the deficiency in Matsumi.

Accordingly, the Appellants submit that the cited art fails to disclose or suggest all of the elements of claims 2-4, 6-7, and 9-10.

C. The Examiner has Failed to Establish Prima Facie Obviousness

For at least the reasons set forth above, the Appellants submit that the applied cited art fails to teach or suggest, either implicitly or explicitly, all of the elements of the presently claimed invention. Accordingly, the Appellant respectfully submits that the Examiner has failed to set forth a *prima facie* case of obviousness with respect to claims 1-10.

D. Sufficient Suggestion or Motivation to Combine the References Has Not Been Set Forth

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or combine reference teachings. The Examiner asserts that one of ordinary skill in the art would combine the communication network of Fujinamo with the apparatus of Matsumi in order to allow Matsumi's system to distinguish overwrite recording from append recording.

However, the Appellants submit that the referenced portion of Fujinamo (column 24, lines 45-50) merely mentions that a network and a satellite can be used as presentation media for a computer program in place of a CD-ROM. This feature does not provide the benefit of distinguishing overwrite recording and append recording, as asserted by the Examiner. That feature is provided by other aspects of Fujinamo.

The Examiner has provided no motivation for altering Matsumi by adding this feature of Fujinamo. The only suggestion of combining each of these features is found in the present claims. Therefore, the Appellants submit that there is no motivation


provided in Matsumi, Fujinamo, or the knowledge generally available to one skilled in the art to combine the teachings of Matsumi and Fujinamo. Thus, the Appellants respectfully submit that such a combination is improper to render claims 1-10 obvious.

IX. CONCLUSION

For all of the above-noted reasons, the Appellants respectfully submit that claims 1-10 are not unpatentable under 35 U.S.C. § 103(a), and respectfully request the Honorable Board to reverse the rejection in this case and indicate the allowability of claims 1-10.

In the event that this paper is not considered timely filed, the Appellants respectfully petition for an appropriate extension of time. Any fees for such extension, together with any additional fees which may be due with respect to this paper, may be charged to our Deposit Account No. 01-2300, making reference to attorney docket no. 107156-00094.

Respectfully submitted,


Sheree T. Rowe
Attorney for Appellants
Reg. No. 59,068

Customer No. 004372

Arent Fox LLP
1050 Connecticut Avenue, N.W., Suite 400
Washington, DC 20036-5339
Tel: (202) 857-6000
Fax: (202) 857-6395

APPENDIX I: COPY OF THE CLAIMS ON APPEAL

1. (Previously Presented) An information recording and reproducing apparatus for recording program information reproduced from an information recording medium or program information supplied via a communication network into recording device, said apparatus comprising:

a first recording unit, provided in said recording device, for recording said program information reproduced from the information recording medium or said program information supplied via the communication network; and

control means for, when said program information is recorded into said first recording unit, (a) obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network, (b) in case that the title information corresponding to said program information is obtained by searching through a second recording unit based on the management information obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit, and (c) in case that the title information corresponding to said program information is not obtained by searching through said second recording unit based on the management information obtained, appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit,

wherein the second recording unit is provided in said recording device for recording title information corresponding to said program information prior to recording said program information, and

wherein said title information comprises at least one of disc title, the name of artist, genre, the year of sale of disc, track title and the artist(s) for respective track(s).

2. (Original) The information recording and reproducing apparatus according to claim 1, wherein, when updated title information is supplied by way of an information recording medium or via the communication network, said control means records said updated title information into said second recording unit, and searches through said second recording unit (after updating) for the title information corresponding to said program information appended with the information indicating the absence of the title information, and when the title information corresponding to said program information is obtained, said control means appends the title information obtained to said program information so as to be recorded into said first recording unit.

3. (Original) The information recording and reproducing apparatus according to claim 2, wherein said control means searches through said second recording unit after updating, based on the management information for managing said program information appended with the information indicating the absence of the title information.

4. (Original) The information recording and reproducing apparatus according to claim 2, further comprising one of the following:

reproducing means for reproducing the information recording medium having recorded the updated title information; and

receiving means for receiving the updated title information supplied via the communication network.

5. (Previously Presented) A method for appending title information to program information reproduced from an information recording medium or program information supplied via a communication network so as to be recorded into recording device, said method comprising:

the step of recording said program information reproduced from the information recording medium or said program information supplied via the communication network into a first recording unit provided in said recording device;

the step of, when said program information is recorded into said first recording unit, obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network, and, based on the management information obtained, searching through a second recording unit equipped in said recording device provided for recording title information corresponding to said program information prior to recording said program information; and

the step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained in said step of searching, and appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is not obtained in said step of searching

wherein said title information comprises at least one of disc title, the name of artist, genre, the year of sale of disc, track title and the artist(s) for respective track(s).

6. (Original) The method of appending title information according to claim 5, further comprising:

the step of obtaining updated title information when the updated title information is supplied by way of an information recording medium or via the communication network;

the step of recording the updated title information obtained into said second recording unit, and searching through said second recording unit (after updating) for the title information corresponding to said program information appended with the information indicating the absence of the title information; and

the step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained by searching through said second recording unit after updating.

7. (Original) The method of appending title information according to claim 6, wherein, in said step of searching through said second recording unit after updating, said second recording unit after updating is searched through based on the management information for managing said program information appended with the information indicating the absence of the title information.

8. (Previously Presented) A program recording medium having recorded a title information appending procedure program for allowing a computer to execute a process to append title information to program information reproduced from an information recording medium or program information supplied via a communication network so as to be recorded into recording device, the title information appending procedure comprising:

the procedural step of recording said program information reproduced from the information recording medium or said program information supplied via the communication network into a first recording unit provided in said recording device;

the procedural step of, when said program information is recorded into said first recording unit, obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network, and, based on the management information obtained, searching through a second recording unit equipped in said recording device provided for recording the title information corresponding to said program information prior to recording said program information; and

the procedural step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained in said procedural step of searching, and appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is not obtained in said procedural step of searching;

wherein said title information comprises at least one of disc title, the name of artist, genre, the year of sale of disc, track title and the artist(s) for respective track(s).

9. (Original) The program recording medium having recorded a title information appending procedure program according to claim 8, further comprising:

the procedural step of obtaining updated title information when the updated title information is supplied by way of an information recording medium or via the communication network;

the procedural step of recording the updated title information obtained into said second recording unit, and searching through said second recording unit after updating for the title information corresponding to said program information appended with the information indicating the absence of the title information; and

the procedural step of appending the title information to said program information so as to be recorded into said first recording unit when the title information corresponding to said program information is obtained by searching through said second recording unit after updating.

10. (Original) The program recording medium having recorded a title information appending procedure program according to Claim 9, wherein said procedural step of searching through said second recording unit after updating includes the procedural step of searching through said second recording unit (after updating) based on the management information for managing said program information appended with the information indicating the absence of the title information.

APPENDIX II: EVIDENCE

--None submitted--

APPENDIX III: RELATED PROCEEDINGS

--None Submitted--